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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/788,473 | 02/21/2001 | Mikio Kawamoto | 1095.1161/JDH | 6202 |
| 21171 | 7590 | 06/17/2004 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | HOSSAIN, TANIM M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2141 | |

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/788,473 | Applicant(s) KAWAMOTO, MIKIO | |
| | Examiner Tanim Hossain | Art Unit 2141 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/21/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Specification

2. The disclosure is objected to because of the following informalities:
 - a. On page 5 of the Summary of The Description, line 15, the article "the" is missing, pertaining to "preferred embodiment".
 - b. On page 13 of the Description of the Preferred Embodiments, line 1, "The interface 20fe" is a typographical error.
 - c. In figure 16, "Strat" is a typographical error.Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck (U.S. 5,794,039) in view of Kennedy (U.S. 6,134,582).

a. As per claim 1, Guck discloses an electronic-mail transmission/reception apparatus for transmitting and receiving electronic mails comprising:

A condition setting unit which sets in said electronic-mail transmission/reception apparatus a condition for displaying a list of at least one information item on at least one title of at least one electronic mail which have been transmitted or received (column 1, lines 58-60; column 3, lines 6-10; wherein Guck specifically discloses the use of an electronic-mail database, and the "get" request is a condition setting unit. See also column 9, lines 43-47); a sorting unit which sorts said at least one information item into a hierarchical structure according to said condition (column 1, lines 59-62). Guck does not explicitly teach the use of a list-displaying unit. Kennedy discloses the use of an electronic-mail transmission/reception apparatus comprising a list-displaying unit, which displays a list of messages (column 15, lines 12-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a list-displaying unit displaying the returned results of the at least one information item which is sorted by the sorting unit, as taught by Guck in the system of Kennedy, because both Guck and Kennedy are from the same field of endeavor of electronic-mail organization and display. By implementing a list-displaying unit, Guck's invention is further extended.

b. As per claim 2, Guck, in view of Kennedy, discloses an electronic-mail transmission/reception apparatus according to claim 1, wherein said sorting unit sorts said at least one information item according to attribute information which each of said at least one electronic mail has (column 9, lines 45-47).

c. As per claim 3, Guck, in view of Kennedy, discloses an electronic-mail transmission/reception apparatus according to claim 2, wherein said attribute information is contained in a header of said at least one electronic mail (column 9, lines 42-44).

d. As per claim 4, Guck, in view of Kennedy, discloses an electronic-mail transmission/reception apparatus according to claim 1, further comprising a display information removing unit which removes a portion of information displayed by said list displaying unit, according to display capacity of said list displaying unit (column 12, lines 12-18, where a browser with adjustable windows is discussed, when adjusted, a portion of information displayed is removed).

e. Claim 5 is rejected on the same basis as claim 1, as it discusses a method of implementing the contents of claim 1).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Kennedy (6,330,589) teaches a system and method for using a client database to manage conversation threads generated from email or news messages.

b. Horvitz, et al (6,161,130) teaches a classification-by-criteria method for managing electronic mail.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanim Hossain whose phone number is 703/605-1228. The examiner can normally be reached on 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached by phone at 703/305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703/872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tanim Hossain
Patent Examiner
Art Unit 2100

th


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER